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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/601,871	06/24/2003	Masashi Arimoto	018765-142	1328

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EXAMINER

TESKIN, FRED M

ART UNIT PAPER NUMBER

1713

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/601,871

Applicant(s)

ARIMOTO ET AL.

Examiner

Fred M Teskin

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 8-14 is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 092403.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Claims 1-14 are currently pending and under examination herein.

The disclosure is objected to because of the following informalities: the specification at pages 10 (final paragraph), 11 (first full paragraph), 12 (penultimate paragraph) and 16 (bridging paragraph) refers to various copending U.S. applications and EP publications as "incorporated herein". The present status of the referenced applications should be made known to the examiner. Additionally, applicants are reminded that incorporation by reference of *essential* material is proper only for U.S. patents and *allowed* applications, MPEP 608.01(p)(B), and are requested to clarify whether material disclosed in said copending applications is essential to the instant claims within the meaning of 35 U.S.C. 112, 1st paragraph. If so, such material should be added by amendment directly into the text of the specification. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing application. See *In re Hawkins*, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); and *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973).

Appropriate correction of the specification is required.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 1713

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over US 6376095 to Cheung et al, alone or with reference to EP 0416815.

The rejected claims are drawn to a film, wherein the percent strain change 100 hours after applying a load of 3.5 Mpa at a temperature of 23°C is not more than 2.0%, and a percentage strain change 100 hours after applying a load of 0.5Mpa at a temperature of 55°C is not more than 2.5% (claim 1). The claimed film may comprise at least one substantially random or pseudo-random interpolymer comprising polymer units (1) and (2) as defined in dependent claims 3-7.

Cheung et al exemplify films fabricated from substantially random ethylene/styrene interpolymers (ESI), wherein the mole percent contents of styrene and (by implication) ethylene fall within the corresponding mol % ranges for polymer units

(1)(a) and (2) as set forth in each of claims 3-7. See Examples 1-5 of the reference as well as Tables 2 and 3 in cols. 33-35 and col. 9, lines 20+, where the "substantially random" structure of the interpolymers is discussed and where the EP '815 publication is cited for its disclosure of a method of preparing such interpolymers.

According to EP '815, copolymers prepared using a catalyst system comprising a coordination complex having constrained geometry, especially copolymers of ethylene and a hindered aliphatic vinylidene compound or vinylidene aromatic monomer, can *further* be described as "pseudo-random" (see page 8, lines 27-33). Since the ESI used in each of Examples 1-5 of Cheung et al was prepared using such a constrained geometry catalyst (see the footnotes to Table 1), the obtained films are reasonably presumed to comprise species of "pseudo-random" interpolymer within claims 6-7.

As to the claimed parameters of percentage strain change (claim 1) and elastic modulus (claim 2), Cheung et al do not so characterize their exemplified films. Nevertheless, given the identity of interpolymer structure (substantially random) and composition, a plausible basis exists for concluding that those film properties recited in the claims but not disclosed by Cheung et al will inhere to the ESI films of the above-cited examples.

Since this situation involves a 102/103 rejection where the property or characteristic relied upon for patentability may be inherent in the prior art and since the Office obviously does not have facilities to make and test claimed and prior art products, the burden properly shifts to applicants to show that the property or characteristic

Art Unit: 1713

recited in the claims represents an unobvious difference. *In re Best*, 195 USPQ 430 (CCPA 1977).

Claims 8-14 are allowable over the prior art of record.


The following is a statement of reasons for the indication of allowable subject matter: None of the prior art documents located or identified to date, including Cheung et al and EP '815, is seen to teach or fairly suggest the utility of film having the properties as defined in claims 8 and 9 in fastening or holding cargo. Accordingly, method claims 8-14 are deemed to define allowable subject matter.

Any inquiry concerning this communication should be directed to Examiner F. M. Teskin whose telephone number is (571) 272-1116. The examiner can normally be reached on Monday through Thursday from 7:00 AM - 4:30 PM, and can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached on (571) 272-1114. The appropriate fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

FMTeskin/12-10-04


FRED TESKIN
PRIMARY EXAMINER
12/10/04